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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,932	03/22/2004	Michael K. Brown	555255012483	1029
7590 John V. Biernacki, Esq. Jones Day 901 Lakeside Avenue/North Point Cleveland, OH 44114			EXAMINER AJAYI, JOEL	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 05/14/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/805,932	Applicant(s) BROWN ET AL.	
	Examiner JOEL AJAYI	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 25-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 25, 2008 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 1-23, 25-30 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 29 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by **Bouchard (U.S.**

Patent Application Number: 2003/0115448).

Consider **claim 29**; Bouchard discloses an apparatus located at a computer server for handling secure message attachments for a mobile device, comprising:

means for receiving a second attachment (first encrypted email) provided with a secure message (paragraphs 56, 58, 62, lines 4-20); wherein the secure message itself was received by

the server (satellite server) as a first attachment (second encrypted email) (paragraph 62, lines 4-20); means for processing (decrypt and extract) the secure message in order to locate within the secure message the second attachment (paragraph 62, lines 4-20); means for providing the second attachment to the mobile device (paragraph 63, line 1) (even though a desktop is used in this example, the client device can be a wireless device, paragraph 30, lines 1-8).

Consider **claim 30**; Bouchard discloses rendering the second attachment before the second attachment is provided to the mobile device (paragraph 62); a decryption processing module to decrypt the secure message so that the second attachment can be located within the secure message (paragraph 62).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 5-23, 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bouchard (U.S. Patent Application Number: 2003/0115448)** in view of **Picoult et al. (U.S. Patent Application Number: 2002/0065042)**.

Consider **claim 1**; Bouchard discloses a method for handling secure message attachments for a mobile device, comprising the acts:

Receiving at a server (the master server sends the second attachment to the satellite server) second attachment provided within a secure message (paragraphs 56 and 58); wherein the secure message itself was received by the server as a first attachment (second encrypted email) (paragraph 62, lines 4-20); processing at the server the secure message in order to locate within

the secure message the second attachment (first encrypted email) (paragraph 62, lines 4-20); and providing the second attachment to the mobile device (paragraph 63, line 1) (even though a desktop is used in this example, the client device can be a wireless device, paragraph 30, lines 1-8).

Except: requesting the second attachment at the mobile device.

In an analogous art, Picoult discloses requesting any attachments at the mobile device (paragraph 31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Bouchard by including the means for a mobile device to access information, as taught by Picoult, for the purpose of receiving messages with ease and flexibility.

Consider **claim 2**; Bouchard discloses that the secure message is structured according to a security scheme such that the secure message is handled as an attachment by the server (paragraphs 56 and 58).

Consider **claim 5**; Bouchard discloses that the security scheme is a Secure Multipurpose Internet Mail Extensions (S/MIME) scheme (paragraph 58).

Consider **claim 6**; Bouchard discloses that the secure message is structured such that a secure layer has been added to the message and the second attachment (paragraphs 56 and 58).

Consider **claim 7**; Bouchard discloses that the secure layer acts as an envelope with respect to the message and the second attachment (paragraphs 56, 58, 62).

Consider **claims 8, 11**; Bouchard discloses that the secure layer was generated during an encryption operation (paragraphs 56 and 58).

Consider **claim 9**; Bouchard discloses that a session key is received by the server from the mobile device for use by the server to decrypt the secure message (the public key is available to both the server and mobile device. Even though a desktop is used in this example, the client device can be a wireless device, paragraph 30, lines 1-8) (paragraph 62 and 63).

Consider **claim 10**; Bouchard discloses that the secure layer was generated during a digital signature operation (paragraph 58).

Consider **claim 12**; Bouchard discloses that the second attachment is selected from the group consisting of: a textual document, word processing document, audio file, image file, or video file (paragraph 56).

Consider **claims 13-15**; Picoult discloses that the secure message without the second attachment is sent from the server to the mobile device, wherein the second attachment is provided to the mobile device based upon the mobile device requesting the second attachment (there might be a rule from the recipient, determining how the second attachment is handled) (paragraph 31).

Consider **claim 16**; Bouchard discloses that the secure layer was generated during an encryption operation, wherein a decryption operation is performed in order to locate within the secure message the second attachment (paragraph 62).

Consider **claim 17**; Bouchard discloses that the secure message has a plurality of attachments (paragraph 56).

Consider **claim 18**; Picoult discloses that the server provides an indication to the mobile device that the secure message has the second attachment, wherein the indication is used by the

mobile device to indicate to the mobile device's user that the secure message has the second attachment (paragraph 16, lines 1-8).

Consider **claim 19**; Bouchard discloses that the second attachment is automatically provided by the server to the mobile device when the secure message is opened by the mobile device's user (paragraph 62 and 63).

Consider **claims 20**; Bouchard discloses that the second attachment is rendered before being provided to the mobile device (the message is processed) (paragraph 62).

Consider **claim 21**; Bouchard discloses a means for providing a wireless network and means for providing a message server are used to communicate the located attachment to the mobile device (paragraphs 29 and 62).

Consider **claims 22, 23, 25**; Bouchard discloses that the mobile device is a handheld wireless mobile communications device (paragraph 30, lines 1-8).

Consider **claim 26**; Bouchard discloses an apparatus located at a computer server for handling secure message attachments for a mobile device, wherein the server receives a secure message containing a second attachment (paragraphs 56 and 58), comprising:

the secure message contains a secure layer such that the secure message itself is received by the server as a first attachment (second encrypted email) (paragraph 62, lines 4-20); a secure message processing module that looks into the secure message through the secure layer in order to locate the second attachment (first encrypted email) (paragraph 62, lines 4-20); wherein the second attachment is provided to the mobile device (paragraph 63, line 1) (even though a desktop is used in this example, the client device can be a wireless device, paragraph 30, lines 1-8).

Except: a data store that stores the secure message and the second attachment.

In an analogous art, Picoult discloses that the server stores the secure message and any attachments (paragraph 25, lines 8-17; paragraph 31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Bouchard by including the means for a mobile device to access information, as taught by Picoult, for the purpose of receiving messages with ease and flexibility.

Consider **claim 27**; Bouchard discloses rendering the second attachment before the second attachment is provided to the mobile device (paragraph 62).

Consider **claim 28**; Bouchard discloses a decryption processing module to decrypt the secure message so that the second attachment can be located within the secure message (paragraph 62).

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bouchard (U.S. Patent Application Number: 2003/0115448)** in view of **Picoult et al. (U.S. Patent Application Number: 2002/0065042)**, and further in view of **Kiessling et al. (U.S. Patent Number: 6,795,924)**.

Consider **claims 3 and 4**; Bouchard and Picoult disclose the claimed invention except that the security scheme includes a symmetric and asymmetric key scheme.

In an analogous art, Kiessling discloses that the security scheme includes a symmetric and asymmetric key scheme (column 2, lines 12-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Bouchard and Picoult by including symmetric and

asymmetric methods, as taught by Kiessling, for the purpose of providing secure messages to mobile terminals.

Conclusion

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Joel Ajayi whose telephone number is (571) 270-1091. The Examiner can normally be reached on Monday-Friday from 7:30am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Lester Kincaid can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Joel Ajayi

/Lester Kincaid/
Supervisory Patent Examiner, Art Unit 2617